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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,358

12/17/2004

Hiroki Kuyama

OKA-0222

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7590

02/03/2009

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

02/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/518,358	Applicant(s) KUYAMA ET AL.	
	Examiner D. L. Jones	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/15/08; 6/6/06; 1/25/05; 12/17/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,20-22 and 32-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 is/are allowed.
- 6) ☒ Claim(s) 20-22 and 32-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/6/06; 1/25/05; 12/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 12/15/08 wherein claims 1-9, 11-19, 23-31, 44, and 45 were canceled and claims 10, 20-22, and 32-35.

Note: Claims 10, 20-22, and 32-43 are pending.

RESPONSE TO APPLICANT'S ELECTION

2. The Examiner acknowledges receipt of Applicant's election of species made on 12/15/08. Initially, Applicant's elected species was searched. However, since no prior art was cited which could be used to reject the claims, the search was expanded over the full scope of the claims.

112 SECOND PARAGRAPH REJECTIONS

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 20-22 and 32-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 20-22: The claims as written are ambiguous because independent claim 20 is directed to a labeling reagent that is the same as the sulfenyl compound. In other words, the only difference between independent claims 10 and 20 is that in claim 10, the compound is 'represented by the general formula' and in independent claim 20, the compound 'comprises a sulfonyl compound'. Thus, it is unclear what other component is present that makes the sulfenyl compound different from the labeling reagent. Please clarify.

Claim 21: The claim as written is ambiguous is not further limiting because the product does not contain an additional component. Specifically, the phrase 'in a use for peptide analysis' is the intended use of the product, not an additional component present in the product. Applicant is reminded that the utility of a product carries patentable weight in method claims containing active steps.

Claims 32-43: The claims are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. In particular, it is noted that the method does not contain any active steps to perform the desired utility.

Claims 32-43: The claims are ambiguous because it is unclear for what purpose a peptide is being analyzed. Also, the method only discloses the sulfenyl compound. Thus, it is unclear whether Applicant actually intended the claim to be a method of use or product claim.

Claims 32-43: The claims as written are ambiguous and somewhat confusing. Applicant is respectfully requested to review the claim wording and steps and clarify the claims in order that one may clearly ascertain what is being claimed.

Claim 33: The claim as written is ambiguous because it is unclear what steps and compound/compounds Applicant is using to accomplish the desired result/results.

Claim 35: Is the control peptide the same as the peptide of interest because they both are used with the heavy reagent and the light reagent; thus, it is unclear how the two are different and how one would distinguish between them in the method of claim 35.

Claims 36-43: The claims as written are ambiguous because it is unclear what chemical treatment Applicant is referring to that is compatible with the instant invention. In particular, chemical treatment encompasses a multitude of possible techniques that known in the chemical area. However, all of these techniques are not necessarily applicable to the peptides used with Applicant's invention. Thus, Applicant is respectfully requested to clarify the claims in order that one may ascertain what is being claimed.

ALLOWABLE CLAIM

5. Claim 10 is allowable over the prior art of record. In particular, the claim is distinguished over the prior art because the prior art neither anticipates nor renders obvious the specific radiolabeled compounds as set forth in the claims.

PRIORITY DOCUMENT

6. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Note: It is duly noted that Applicant has submitted a certified copy of the priority document. However, it is also noted that an English translation of the document was not provided for review by the Examiner.

COMMENTS/NOTES

7. Applicant is respectfully requested to review the claims for clarity. Review of the claims indicates that awkward claim language is present that makes it difficult to clearly ascertain what is being claimed.

Art Unit: 1618

It should be noted that no prior art has been cited against the instant invention.

However, Applicant MUST address and overcome the 112 rejections above. In particular, the prior art neither anticipates nor renders obvious the specific sulfonyl compounds and uses thereof as set forth in the instant invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. Jones/
Primary Examiner
Art Unit 1618

February 2, 2009